



ATTORNEY DOCKET NO. 01915/13921US03

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

17
Election
D. Boyce
7/22/03

In the Application of:

Carter, *et al.*

Serial No.: 09/924,110

Filed: August 7, 2001

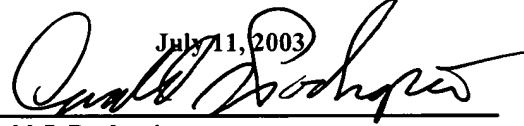
For: " MATERIALS AND METHODS FOR
IMPROVED BONE TENDON BONE
TRANSPLANTATION "

Group Art Unit: 3738

Examiner: Alvin J. Stewart

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450 on this date:

July 11, 2003

Donald J. Pochopien
Registration No. 32,167
Attorney for Applicants

ELECTION OF INVENTION UNDER 35 U.S.C. § 1.121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA, 22313-1450

Sir:

In response to the Official Communication of 05/16/03 ("Official Communication"), for which a response was due 06/16/03, now extended one (1) month to 07/16/03, the Applicants respond to the restriction requirement imposed by the Patent Office by making an election of an invention.

In the Official Communication, the Patent Office says that there are multiple inventions being claimed and that the Applicants are required to claim one of them for examination. The Patent Office has divided the claims into the following three groups of inventions:

- I. Claims 1-11, 27, and 28, directed to a bone tendon graft; and
- II. Claims 12-26, 29, and 30, directed to a method of making the grafts.

In addition, the Patent Office has further required an election of the following list of species:

- I. Figure 2A;
- II. Figures 2B-4; and
- III. Figure 8.

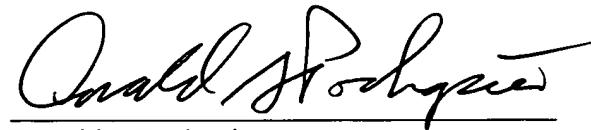
The Applicants elect, with traverse, to prosecute the claims of Group I, Species II, drawn to claims 1-11, 27, and 28 and directed to a bone tendon graft as depicted in Figures 2A-4.

The Applicants traverse the Examiner's assertion that the present claims are directed to patentably distinct species. Additionally, the Applicants traverse the Examiner's assertion that no generic claims have been found. Applicants respectfully assert that claim 1, as presently recited, generically encompasses Species I-III. Furthermore, Applicants respectfully state that a search and examination of Groups I and II would not represent a serious burden on the Examiner. See MPEP § 803. ("There are two criteria for a proper requirement for restriction between patentably distinct inventions: the invention must be independent or distinct as claimed; and there must be a serious burden on the Examiner if a restriction is required.") Therefore, restriction between Groups I and II, and the requirement for election between Species I-III is improper. Applicants respectfully request rejoinder of Group I and II and examination of Groups I and II on the merits.

Respectfully submitted,

McANDREWS, HELD & MALLOY, LTD.

By:



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Date: July 11, 2003

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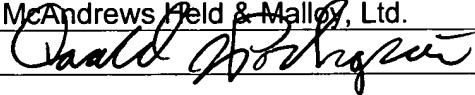

3738/8

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM		Application Number	
(to be used for all correspondence after initial filing)		09/924,110	
		Filing Date	
		August 7, 2001	
		First Named Inventor	
		Carter, et al.	
Group Art Unit		3738	
Examiner Name		Alvin J. Stewart	
Attorney Docket Number		01915/13921US03	
Total Number of Pages in This Submission		5	
ENCLOSURES (check all that apply)			
<div><div><input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53</div><div><input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD Number of CD(s) _____</div><div><input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): - Election of Invention under 35 U.S.C. § 1.121</div></div>			
RECEIVED			
JUL 21 2003			
TECHNOLOGY CENTER R3700			
Remarks			
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual Name		McAndrews Held & Malloy, Ltd.	
Signature		 Reg. No. 32,167	
Date		July 11, 2003	
CERTIFICATE OF MAILING			
"Express Mail" mailing label number _____			
Date of Deposit: _____			
Name (Print/type)		Donald J. Pochopien	
Registration No. (Attorney/Agent)		32,167	
Signature		 Date July 11, 2003	



PTO/SB/17 (11-00)

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FEE TRANSMITTAL for FY 2003

Patent Fees are subject to annual revision.

Complete if Known

Application Number	09/924,110
Filing Date	August 7, 2001
First Named Inventor	Carter, et al.
Examiner Name	Alvin J. Stewart
Group Art Unit	3738
Attorney Docket No.	01915/13921US03

TOTAL AMOUNT OF PAYMENT (\$)**110.00****METHOD OF PAYMENT**

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number
Deposit
Account
Name

13-0017

McAndrews Held & Malloy

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☐ Applicant claims small entity status.
See 37 CFR 1.27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION**1. BASIC FILING FEE**

Large Entity Fee Code	Small Entity Fee Code	Fee Description	Fee Paid
1001 750	2001 375	Utility filing Fee	
1002 330	2002 165	Design filing Fee	
1003 520	2003 260	Plant filing fee	
1004 750	2004 375	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES

	Extra Claims	Fee from below	Fee Paid
Total Claims	<input type="text"/> - 20** =	<input type="text"/> x <input type="text"/> =	<input type="text"/>
Independent Claims	<input type="text"/> - 3** =	<input type="text"/> x <input type="text"/> =	<input type="text"/>
Multiple Dependent		<input type="text"/> =	<input type="text"/>

Large Entity Fee Code	Small Entity Fee Code	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	**Reissue independent claims over original patent
1205 18	2205 9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above